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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,760	07/26/2001	Peter S. Atherton	PARP-129XX	7473
207	7590	02/09/2004	EXAMINER	
WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP TEN POST OFFICE SQUARE BOSTON, MA 02109			TWEEL JR, JOHN ALEXANDER	
			ART UNIT	PAPER NUMBER

2636

DATE MAILED: 02/09/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/915,760

**Applicant(s)**

ATHERTON ET AL.

**Examiner**

John A. Tweel, Jr.

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-50, 52, 54-57 and 60-65 is/are allowed.
- 6) ☒ Claim(s) 51, 53, 58 and 59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. This Office action is in response to the amendment filed 11/17/03. Claims 1-13 have been withdrawn from consideration. Claims 51-53 have been amended.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 51 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by **Connolly et al** [U.S. 5,644,295].

For claims 51 and 53, the adhesion (No. 8) of the Connolly reference effects the destructibility of the security device by changing the adhesive properties between certain electronic components of the security device.

4. Claims 58 and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by **Lauro et al** [U.S. 5,604,485].

For claim 58, Figures 1-3 of the Lauro reference depict several transponders onto a single substrate.

For claim 59, the transponders of Lauro operate at several different frequencies.

5. Claims 14-50, 52, 54-57, and 60-65 contain allowable subject matter.

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6. The following is a statement of reasons for the indication of allowable subject matter:

The particular chemical composition and specific methods of applying said chemical composition is not to be found in the prior art when applied to a flexible tamper-indicating label.

### ***Response to Arguments***

#### ***Argument 1:***

"The Connolly reference neither teaches nor suggests providing a tamper indicating label including a transponder, which is described in the instant application as an RFID transponder including an RFID memory chip and an antenna (see page 20, lines 19-23, of the application). Clearly, the electrically conductive strip connected to the alarm apparatus via the pair of contacts, as described by Connolly et al., cannot be construed as an antenna of a transponder, as recited in claims 51 and 53."

#### ***Argument 2:***

"Not only does the Connolly reference fail to give any hint about providing a tamper indicating transponder label, but it also fails to disclose modifying the destructibility properties of destructible tamper indicating tracks used in the tamper indicating transponder label by changing the adhesive used to apply the label to an object or surface, as recited in base claim 51. Instead, Connolly et al merely disclose that the bond directly between the adhesive layer and the track is weaker than that

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directly between the track and the upper flexible member, but stronger than that directly between the release layer and the upper flexible member (see column 3, lines 40-44, of Connolly et al)."

**Argument 3:**

"Connolly et al. merely disclose the adhesion layer 8 - Connolly et al. disclose nothing about an adhesion modifying coating that may be employed to change the properties of the adhesion layer 8. Because Connolly et al. fail to disclose an adhesion modifying coating, the Connolly reference is silent about modifying the pattern of an adhesion modifying coating, as recited in amended claim 53."

**Argument 4:**

"...the Applicants respectfully submit that the Lauro reference fails to disclose anything about a flexible tamper indicating transponder having two or more transponders incorporated onto a single substrate, in which the transponders operate at two or more frequencies or protocols, as recited in claims 58-59. It is well settled that for 102 anticipation, a single reference must teach each and every element of the rejected claim."

7. Applicant's arguments filed 11/17/03 have been fully considered but they are not persuasive.

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***Response to Argument 1:***

Nowhere in amended claim 51 is there any mention of any RFID transponder including an RFID memory chip and an antenna. A transponder is defined as an electronic device that automatically transmits a signal in response to an outside input. As this definition meets the prior art, the above rejection is considered correct and proper. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Response to Argument 2:***

The Examiner appreciates the Applicant's keen observation and delineations between the track and the adhesive layer and the release layer and the upper flexible member of Connolly. However, claim 51 merely states that the modification involves changing an adhesive used to apply the transponder label to an object or surface. The different bonds pointed out by the applicant above in addition to stating that the strength of the bonds between the various layers are different is certainly a change in the adhesive in the device. Picking and choosing which layers of the device are weaker or stronger are irrelevant. The adhesion properties of the label found in Connolly have been changed. Therefore, the rejection above stands.

***Response to Argument 3:***

The adhesion coating used in the Connolly reference is certainly modified as seen in Figures 1 and 3 to leave portions (Nos. 9 and 10) that remain on the upper member and the adhesive layer. This is an example of a predictable pattern found in the label that is modified to alert the theft thereof. As there is no appreciable difference between the claim language and the prior art, the rejection stands.

***Response to Argument 4:***

In response to applicant's arguments, the recitation tamper indicating has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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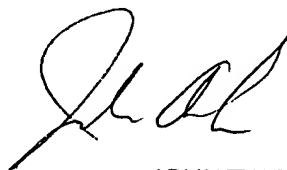
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. Tweel, Jr. whose telephone number is 703 308 7826. The examiner can normally be reached on M-F 10-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Hofsass can be reached on 703 305 4717. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JAT  
2/7/04



JOHN TWEEL  
PRIMARY EXAMINER